Immunocept, LLC, et al v. Fulbright & Jaworski Doc. 18

FILED
DEC 15 2005
CLERK, U.S. DISTRICT COURT
WESTERN DISTRICT OF TEXAS
BY ______ DEPUTY CLERK

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON,	§	
	§	
Plaintiffs,	§	
	§	
vs.	§	**CAUSE NO. A 05 CA 334 SS**
	§	
FULBRIGHT & JAWORSKI, LLP,	§	
	§	
Defendant.	§	

PLAINTIFFS' MOTION TO COMPEL TESTIMONY OF SARAH BRASHEARS

TO THE HONORABLE COURT:

COMES NOW Plaintiffs Immunocept, LLC, Patrice Anne Lee, and James Reese Matson (collectively "Plaintiffs") and file this Motion To Compel Testimony of Sarah Brashears against Fulbright & Jaworski, LLP ("Fulbright" or "Defendant"), and would respectfully show the Court as follows:

I.
INTRODUCTION

This legal malpractice case involves a dispute arising from a patent prosecution performed by Defendant Fulbright & Jaworski. During the deposition of Sarah Brashears ("Brashears"), a former employee of Fulbright, Defendant's counsel objected and instructed Brashears not to testify regarding (1) her communications with Tom Paul ("Paul"), a at partner at Defendant Fulbright, and (2) her communications during meetings with counsel for Fulbright David Beck ("Beck"), Rodney Caldwell ("Caldwell"), and Geoff Gannaway ("Gannaway"). As a basis for these objections, Defendant's counsel asserted that the attorney-client privilege and

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work product privilege apply to these communications because of Brashears' status as a former employee of Defendant. Defendant's objections should be overruled. *First*, the attorney-client privilege does not apply to Brashears' communications with Paul because he is not counsel for Fulbright. *Second*, there is no basis in Texas law for extending attorney-client privilege to communications between counsel for a party and a former employee of that party. *Third*, the purpose of the privilege is incompatible with its application in the context of communications between a party's counsel a former employee, particularly when that former employee is over nine years removed from their employment. *Finally*, the work product privilege cannot be utilized to prevent Brashears – a third party in this case – from being asked about communications between herself and Fulbright and/or its representatives. As a result, this Court should overrule Gannaway's objections and order Brashears to testify regarding these communications. In addition, this Court should award Plaintiffs reasonable and necessary attorneys fees and costs that will be incurred in the re-deposition of Brashears.

II.
FACTUAL BACKGROUND

On October 18, 2005, the parties in this case took the deposition of Sarah Brashears, a former employee of Fulbright. Brashears was a full-time attorney in the intellectual property department of Fulbright from approximately August of 1993 through July of 1996. *See* Brashears Depo. p. 15:5-7; 17:15-20; 41:1-3, 17-20. During her employment at Fulbright, Brashears was involved in the patent prosecution at issue in this lawsuit. *Id.* p. 53:4-15. Brashears currently resides in California and her deposition was taken in Menlo Park, California. *Id.* p. 4:12-15.

During Plaintiffs' counsel Michael P. Lynn's ("Lynn") examination of Brashears, Lynn questioned Brashears about her preparation for her deposition. Specifically, Lynn asked whether

Brashears had discussions with anyone about her deposition. *Id.* p. 27:2-4. Brashears responded affirmatively. *Id.* p. 27:4.

First, Brashears testified about a conversation she had with Tom Paul, a partner at Fulbright, in which Paul asked her if she remembered the case in question and she stated that she did remember it. *Id.* p. 27:18-25; 28:1-3. Brashears was no longer an employee of Fulbright at the time of this conversation. *Id.* p. 28:25-29:1-3. Lynn asked what else Brashears discussed with Paul. *Id.* p. 28:6. Counsel for Fulbright Geoff Gannaway then objected and instructed Brashears not to answer on the basis of attorney-client privilege and work product privilege. *Id.* p. 28:7-9. Gannaway further explained his objection to Brashears' testimony:

> She's a former employee of the firm who was being conferred with by counsel or with members of the firm only for the purposes of her knowledge from – that she gained while she was at Fulbright.

Id. p. 28:7-13. Brashears testified that Fulbright was not representing her at the time of her conversation with Paul, nor were they representing her at the time of her deposition. *Id.* p. 28:14-18. As a result of Gannaway's unfounded objections asserting the attorney-client and work product privileges, Brashears refused to testify as to what was said during the conversation with Paul except to say that they had discussed the substance of the lawsuit. *Id.* p. 31:4-14.

Brashears also testified that in 2004 she had a two-hour meeting with counsel for Fulbright David Beck and Rodney Caldwell during which she was interviewed about the facts of this lawsuit. *Id.* p. 32 and 33:1-20; 35. Brashears was not employed by Fulbright at the time of this meeting. *Id.* p. 36:1-3. Indeed, at the time of this meeting, it had been over nine years since Brashears had been an employee at Fulbright. *Id.* p. 15:5-7; 17:15-20; 41:1-3, 17-20

When Lynn asked what was said in the meeting, Gannaway again objected and instructed Brashears not to answer on the basis of attorney-client privilege and work product privilege. *Id.*

p. 33:8-11; 35. Brashears admitted that she was not represented by Fulbright at that time. *Id.* p. 33:12-14. Further, she stated she was not represented by Beck or Caldwell. *Id.* p. 35:20-25. As a result of Gannaway's unfounded objections asserting the attorney-client and work product privileges, Brashears refused to testify as to the conversations with Beck and Caldwell during this meeting. *Id.* p. 35.

Finally, Brashears testified that she met with Gannaway and Caldwell for approximately two hours the day before her deposition. *Id.* p. 37:16-21; 38:3. When Lynn asked what was said during this meeting, Gannaway objected and instructed Brashears not to answer based on the attorney-client privilege and work product privilege. *Id.* p. 38:6-9. Brashears confirmed that she was not represented by Fulbright, Gannaway or Caldwell during the course of the meeting. *Id.* p. 38:10-14. She testified that she met with them as a witness, and that they discussed her memory of events and documents in preparation for her deposition. *Id.* p. 38:16-23. Once again, Gannaway's groundless objections prevented Brashears from testifying about the discussions during this meeting.

Gannaway's objections prevented Brashears from testifying as to (1) Brashears' discussion with Paul, (2) Brashears' meeting with Beck and Caldwell, and (3) Brashears' meeting with Gannaway and Caldwell. As discussed in this motion, the attorney client and work product privileges do not apply to these communications. As a result, this Court should overrule Gannaway's objections and compel Brashears to testify regarding these communications.

III.
ARGUMENT

1. The Attorney-Client Privilege Does Not Apply To Communications Between Brashears And Paul Because Paul Is Not Counsel For Fulbright

As described *supra*, during Brashears' deposition, Gannaway instructed Brashears not to testify as to her conversation with Paul based on the attorney-client privilege. *Id.* 28:7-9. Under

Texas law, the elements of the attorney-client privilege are: (1) a confidential communication, (2) made for the purpose of facilitating the rendition of professional legal services, (3) between or amongst the client, lawyer, and their representatives; and (4) the privilege has not been waived. TEX.R.EVID. 503(b); *Huie v. DeShazo*, 922 S.W.2d 920, 923 (Tex. 1996). The attorney-client privilege applies only to communications "made for the purpose of facilitating the rendition of professional legal services to the client." *Id.*

Tom Paul is a partner at the law firm of Fulbright. *See* Brashears Depo. p. 27:18-20. He does not serve as counsel for Fulbright. As a result, even if the attorney-client privilege applies to Brashears as a former employee of Fulbright (which it does not as explained *infra)*, such privilege does not extend to communications between Brashears and Paul, because Paul is not counsel to Fulbright. Therefore, the communication between Brashears and Paul is not one between or amongst the client, lawyer, and their representatives, as required by the attorney-client privilege. TEX.R.EVID. 503(b); *Huie v. DeShazo*, 922 S.W.2d 920, 923 (Tex. 1996). As a result, Gannaway's objection should be overruled and Brashears should be compelled to testify as to her communications with Paul.

2. **The Attorney-Client Privilege Does Not Apply To Communications Between Brashears And Counsel For Fulbright Because The Privilege Has Not Been Applied To Former Employees Under Texas Law**

Gannaway objected and instructed Brashears not to testify regarding her conversations with counsel for Fulbright on the basis of attorney-client privilege. *See* Brashears Depo. p. 33:8-11; 35; 38:6-9. The first communications at issue took place during a meeting between Brashears, Beck and Caldwell in 2004. *Id.* p. 32;33:1-20;35. The second communications took place during a meeting between Brashears, Gallaway, and Caldwell the day before Brashears' deposition. *Id.* p.37:16-21;38:3. These discussions took place when Brashears was no longer employed by Fulbright and had not been for over nine years. *Id.* p.28:25;29:1-3;36:1-3.

Moreover, Brashears specifically testified that she has never been represented by Beck, Caldwell, Gannaway, or the firm of Fulbright. *Id.* 28:14-18;33:12-14;35:20-25;36:1-3. ***Gannaway based his objections solely on the fact that Brashears is a former employee of Fulbright.*** As noted previously in this motion, Gannaway stated:

> She's a former employee of the firm who was being conferred with by counsel or with members of the firm only for the purposes of her knowledge from – that she gained while she was at Fulbright.

Id. p. 28:7-13.

This court should overrule Fulbright's novel privilege objection for two principle reasons. First, and most fundamentally, there is no basis for such an assertion of privilege under Texas law.[1] The Texas Rules of Evidence specifically delineate the categories of communications protected by attorney-client privilege. None of the specifically listed categories include communications between a party's attorney and a former employee of a party. *See* Rule 503(b)(1). Moreover, no Texas court has ever interpreted any category listed in Rule 503(b) to encompass such communications.

Second, as several federal courts addressing this specific question have concluded, such an assertion of privilege in incompatible with the underlying justification for the attorney-client privilege. *See, e.g., Infosystems, Inc. v. Ceridian Corp.*, 197 F.R.D. 303 (E.D.Mich. 2000); *Clark Equip. Co. v. Lift Parts Mfg. Co.*, 1985 WL 2917 at *5 (N.D.Ill. 1985). *Clark Equip. Co.* is particularly instructive on this point. There, during the deposition of two third-party witnesses who were former employees of Defendant, counsel for Defendant asserted attorney-client privilege to preclude inquiry into pre-deposition (but post-employment) conversations between the deponents and Defendant's counsel concerning the witness' prior employment with Defendant. Plaintiff filed a motion to compel. Relying on the reasoning of the Supreme Court of the United States in *Upjohn Co. v. United States*, 449 U.S. 383, 390 (1981), the court concluded that attorney-client privilege did not extend to "post-employment communications with former employees of a corporate party." *Clark Equip. Co.* at *5. The basis of the court's conclusion was its observation that the underlying purpose of the attorney-client privilege – to "encourage full and frank communication between attorneys and their clients . . . and to encourage clients to make full disclosure to their attorneys" –had no force in the context of communications with former employees of a client. As the court reasoned, "[F]ormer employees are not the client. They share no identity of interest in the outcome of the litigation. Their willingness to provide information is unrelated to the directions of their former corporate superiors, and they have no duty to their former employer to provide such information." *Id.*

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[1] Though this case requires the application and interpretation of federal patent law, the asserted legal malpractice claim has a state law basis. Accordingly, under Rule 501 of the federal rules of evidence, the Texas state law of privilege applies. FED. R. EVID 501; *see also In re Avantel, S.A.*, 343 F.3d 311 (5th Cir. 2003) (holding that "in cases where state law supplies the rule of the decision . . the privilege of a witness, person, government, State, or political sub-division thereof shall be determined in accordance with State law.")

The court went on to note one other significant problem with extending the privilege to communications with former employees – the fact that "it is virtually impossible to distinguish the position of a former employee from any other third party who might have pertinent information about one or more corporate parties to a lawsuit." As the court implicitly reasoned, if the positions of former employees and those of regular third-party witnesses could not be meaningfully distinguished, it made no sense to extend the privilege to the former but not the latter. The *Infosystems* court expressed similar misgivings about selectively applying the privilege to former employees with relevant information while simultaneously withholding that privilege from any other third-party with similarly relevant information. 197 F.R.D. at 306 ("Counsel's communications with a former employee of the client corporation generally should be treated no differently from communications with any other third-party fact witness").

The application of the attorney-client privilege to communications with former employees is not recognized by Texas law. Furthermore, such an extension of the privilege is inconsistent with the underlying purpose of the privilege, particularly here, where Brashears is over nine years removed from her employment at Fulbright. Accordingly, this court should overrule Fulbright's Gannaway's objection to Brashears' testimony and Brashears should be compelled to testify as to her communications with counsel for Fulbright.

3. The Work Product Privilege Does Not Apply To Brashears' Communications With Paul Or Counsel For Fulbright

The work product privilege applies to "a communication made in anticipation of litigation or for trial ***between a party and the party's representatives***, including the party's attorneys, consultants, sureties, indemnitors, insurers, employees, or agents." Tex. R. Civ.P. 192.5(a)(2) (emphasis added). The privilege protects the attorney's or the attorney's representative's mental impressions, opinions, conclusions, or legal theories. Tex. R. Civ. P. 192.5(b)(1). As explained *supra*, Brashears is not a representative of Fulbright, but is merely a former employee. As such, her position in this case is identical to that of any other third party. And just as work product privilege would not bar Plaintiffs from asking any other third party in this case about their conversations with Fulbright and/or its attorneys, work product privilege cannot be utilized to bar such questions of *this* particular third party. Accordingly, Fulbright & Jaworksi's work product objections to Brashears testimony have no merit and should be overruled. The Court should order Brashears to answer questions concerning her communications with Paul and Fulbright's counsel.

4. This Court Should Award Plaintiffs Reasonable and Necessary Attorneys Fees and Costs That Will be Incurred in the Re-deposition of Brashears

To re-depose Brashears, Plaintiffs would incur attorneys' fees and significant costs, including travel expenses to and from California for the deposition. Because Defendant's objections are unfounded, Plaintiff is entitled to its reasonable and necessary attorneys' fees and costs associated with Brashears re-deposition. Such fees and costs are more fully described in the Affidavit of Mike Lynn, attached as Exhibit A hereto. Plaintiffs respectfully request this Court to award Plaintiff such reasonable and necessary attorneys' fees and costs.

IV.
CONCLUSION AND PRAYER

Gannaway's objections preventing Brashears from testifying as to Brashears communications with Paul and Brashears communications with Fulbright's counsel are without merit and should be overruled. Plaintiffs respectfully request that the Court compel Brashears to testify fully regarding these communications. Plaintiffs also respectfully requests this Court to award Plaintiffs their reasonable and necessary attorneys' fees and costs associated with the re-deposition of Brashears. Plaintiffs further pray for such additional relief to which it may be entitled.

Respectfully submitted,

Michael P. Lynn, P.C.
State Bar No. 12738500
Jeffrey M. Tillotson, P.C.
State Bar No. 20039200
John Volney
State Bar No. 24003118
Jeremy A. Fielding
State Bar No. 24040895
LYNN TILLOTSON & PINKER, LLP
750 N. St. Paul Street, Suite 1400
Dallas, Texas 75201
(214) 981-3800 Telephone
(214) 981-3839 Facsimile

ATTORNEYS FOR PLAINTIFFS

CERTIFICATE OF CONFERENCE

Counsel for movant and counsel for respondent have personally conducted a conference at which there was a substantive discussion of every item presented to the Court in this motion and despite best efforts the counsel have not been able to resolve those matters presented.

Certified to the 13th day of December, 2005, by

Jeremy A. Fielding

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served as shown below on this the 13th day of December, 2005:

Via Facsimile
David J. Beck, Esq.
Geoff Gannaway, Esq.
BECK, REDDEN & SECREST, L.L.P.
One Houston Center
1221 McKinney Street, Suite 4500
Houston, Texas 77010
(713) 951-3700 Telephone
(713) 951-3720 Facsimile
Attorneys for Fulbright & Jaworski, LLP

Jeremy A. Fielding

EXHIBIT A

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON,	§	
	§	
Plaintiffs,	§	
	§	
vs.	§	**CAUSE NO. A 05 CA 334 SS**
	§	
FULBRIGHT & JAWORSKI, LLP,	§	
	§	
Defendant.	§	

AFFIDAVIT OF MICHAEL P. LYNN
IN SUPPORT OF PLAINTIFFS' ATTORNEYS' FEES AND COSTS

STATE OF TEXAS	§
	§
COUNTY OF DALLAS	§

BEFORE ME, the undersigned authority, on this day personally appeared Michael P. Lynn, who, being by me duly sworn on his oath, deposed and stated:

1. My name is Michael P. Lynn. I am an attorney of record for IMMUNOCEPT, LLC, PATRICE ANN LEE, AND JAMES REESE MATSON ("Plaintiffs"), and I make this affidavit in support of an award of attorneys' fees and costs for Plaintiffs against Defendant Fulbright & Jaworski for the re-deposition of Sarah Brashears. I have personal knowledge of each statement set forth herein, and each such statement is true and correct.

2. I am over the age of twenty-one years, and I am fully competent to make this Affidavit.

3. I practice law through a professional corporation, Michael P. Lynn, P.C. Michael P. Lynn, P.C., is a name partner with the law firm of Lynn, Tillotson & Pinker L.L.P. Lynn

Tillotson & Pinker L.L.P. is a litigation "boutique" specializing in commercial litigation matters. My particular practice concentrates on commercial litigation, including complex cases and class actions. I also have served as an expert witness in several cases, including opining as to the reasonableness of attorneys' fees. Additionally, I have been a speaker on class actions and complex litigation.

4. I have practiced as a civil/commercial litigator for over twenty-eight years. Based on my experience, I am familiar with rates charged by attorneys in Dallas.

5. To prepare this affidavit, I have estimated based on my own work and discussions with the other attorneys working on this matter the amount of time that will be spent taking another deposition of Sarah Brashears. I have also reviewed the costs expenses associated with travel to and from California for such a deposition. I have further reviewed all other costs related to such a deposition, including court reporter costs.

4. I am familiar with the customary and reasonable attorneys' fees charged in Dallas County and surrounding counties for cases of this type. I am familiar with the work that has been done on this case. Based on my personal knowledge of the work done in this case, I have an opinion as to what a reasonable attorneys' fee would be in this matter.

5. In my opinion, the rates charged by our firm for the attorneys and paralegals involved in this matter constitute normal, customary and reasonable charges in Dallas County, Texas for the services rendered.

6. Based upon the time and labor required, the customary fees in cases similar to this one in Dallas County, Texas, the amount in controversy, the experience and the reputation and ability of the attorneys involved, I am of the opinion that $3,000.00 would be a reasonable and necessary attorneys' fee award for re-deposing Sarah Brashears.

7. Based on my examination of costs and expenses associated with travel to and from California for the re-deposition of Sarah Brashears, I am of the opinion that $1500.00 would be the reasonable and necessary travel expenses associated with such a deposition.

8. Based on my examination of customary fees and costs charged by court reporters and videographers, I am of the opinion that $1000.00 would be the reasonable and necessary court reporter costs associated with Brashears' re-deposition.

AFFIANT SAYS NOTHING FURTHER.

____
Michael P. Lynn

SUBSCRIBED AND SWORN TO, before me, the undersigned authority, by Michael P. Lynn on the 13th day of December, 2005.

____
NOTARY PUBLIC IN AND FOR
THE STATE OF TEXAS

Karrie L. Stovall
(Printed Name of Notary Public)

MY COMMISSION EXPIRES: 4/6/08

Karrie L Stovall
Notary Public, State of Texas
My Commission Expires:
April 6, 2008